

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: William Alan Burris et al. **GROUP:** 1744

APPLICATION NO: 10/074,992 **EXAMINER:** K. Jastrzab

FILED: February 13, 2002 **CONFIRMATION:** 6883

FOR: OPERATORY WATER DISINFECTION SYSTEM

Mail Stop: **Petition**

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION TO INVOKE THE COMMISSIONER'S SUPERVISORY AUTHORITY
UNDER 37 C.F.R. 1.181

Applicants respectfully request the Honorable Commissioner of Patents to invoke the Honorable Commissioner's supervisory authority under 37 C.F.R. 1.181 and require the Examiner to properly examine the above-identified application and to withdraw the finality of the present Office Action.

In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

STATEMENT OF FACTS

1. Applicants received a first Office Action on the merits in this case dated April 7, 2005.

2. In response Applicants filed a response with claim amendments on July 7, 2005. In addition to amending certain claims, Applicants traversed the various rejections set forth in the April 7, 2005 Office Action.

3. In a Non-Final Office Action dated September 16, 2005, the prior art rejections were withdrawn and new prior art rejections were set forth. Also the prior §112, second paragraph, rejection was maintained relative to claims 5-6 and 16-17.

4. Applicants filed a further response with claim amendments on December 16, 2005. In that response Applicants further amended the claims of the application, particularly claims 5, 16, 17, to overcome the remaining §112, second paragraph, rejections. Applicants also traversed the prior art rejections on various grounds. Included in Applicants response of December 16, 2005 was a reply to the new prior art rejections under §103(a). In the response, Applicants stated that

“in view of the incomplete rejections (several dependent claims having no basis for rejection set forth), should such rejections be maintained, Applicants must be permitted an opportunity to further amend or respond to the rejections only when they have been set forth with sufficient clarity as to permit a response. Applicants therefore submit that the rejections set forth in the Office Action are incomplete relative to dependent claims 2 - 5, 7 - 12 and 14 - 31, the limitations of many of which (other than claim 13), have not been indicated as being found in either Contreras or Burris ‘993.” (*Applicants Amendment & Response submitted Dec. 16, 2005*)

4. In a Final Office Action mailed March 3, 2006, the Examiner repeated the rejections of the September 16, 2005 Office Action in large part in the same manner as previously set forth. Specifically, the rejections for the thirty pending claims (1-5, 7-31) were indicated as follows:

“Claims 1-5 and 7-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Contreras U.S. patent No. 5,824,243 in view of Burris U.S. patent No. 5,207,993.

Contreras teaches a water ozonating system having a corona discharge ozone generator coupled to a water reservoir and pressurized liquid circulation system, to dispense active, disinfecting ozonated water to the circulation lines of a dental operatory unit to kill microorganisms therein. A check valve is provided to ensure that water does not reach the ozone generator, pressure control means are provided including a pump for pressurized circulation of the ozonated water. Control means are further provided to control activation, operation and delivery of the water. Ozone is mixed with the water in the reservoir through a diffuser and the action of the pump means and a venturi. Off gas is captured and returned to the reservoir. See the abstract, column 3, lines 35-68 and column 4, lines 11-20.

Burris et al., '993 teach a water purification device for point-of-use application wherein there is a liquid source, a corona discharge ozone generator, hydrophobic means for preventing access to the ozone generator by the liquid, means for mixing the ozone and liquid, means for circulating the ozonated liquid, means for separating excess ozone gas from the ozonated liquid and destroying that excess ozone prior to atmospheric release, and means for maintaining the liquid source. Burris et al., '993 provide a positive pressure pump for mixing and circulating the ozonated water, while teaching the equivalence of static diffusers and venture means, as well. Burris et al., '993 teach the use of the device for provision within offices or compact location such as under sinks. See

column 2, lines 40-68, column 3, lines 5-35 and 55-68, column 4, line 23 through column 5, line 35, and the figures.

It would have been well within the purview of one of ordinary skill in the art to employ the ozone off-gas destruction means of Burris in the system of Contreras, because it would provide for the safe disposal of that off-gas if the system requires abrupt shut-down which would not allow for the time consuming, natural dissipation of the off-gas as required by return of the off-gas to the reservoir.

With respect to claim 13, it would have been obvious to one of ordinary skill in the art to substitute the check valve protecting the ozone generator of Contreras with the porous, hydrophobic barrier means of Burris because it would provide a more simply means of protecting the generator irrespective of the pressure within the system and without mechanically moving parts." (*Final Office Action*, pp. 2-4)

Claims 1-5 and 7-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhard et al., U.S. patent No. 5,942,125 in view of Burris '993.

Engelhard et al., teach substantially the invention as claimed, namely an ozone generator connected to a source of compressed air and a water line, with means to mix ozone and water to provide an active, ozonated water for distribution to the circulation lines of a dental operatory unit. Pressure control and monitoring means are provided as well as ozone sensors, and the operation of the system is controlled based on those measured parameters. Off gas is sent through means to destroy any residual ozone prior to release to the atmosphere. Means are also provided to protect the ozone generator from contact with water. The ozone generator of Engelhard et al., is an UV generator. See column 2, lines 33-40, column 3, lines 35-68, column 4, lines 10-20 and lines 31-43, and column 5, lines 10-35.

Burris is applied as set forth above.

It would have been well within the purview of one of ordinary skill in the art to substitute the corona discharge ozone generation means of Burris for the UV generator of Engelhard et al., because of their conventionally recognized functional equivalence.

With respect to claim 13, it would have been obvious to one of ordinary skill in the art to substitute the check valve protecting the ozone generator of Engelhard et al., with the porous, hydrophobic barrier means of Burris because it would provide a more simply means of protecting the generator irrespective of the pressure within the system and without mechanically moving parts.

The Final Office Action fails to specifically set forth where the claim limitations of, for example, dependent claims 14 (liquid source providing pressure), 19 (ozone sensor connected to an alarm), 23 (operatory unit dried air used as oxygen source ozone generator), 25 (control system responsive to lack of supply water). Absent an indication as to the teachings relied upon in the cited patents to teach such limitations, Applicants were left to “guess” at what the Examiner relied upon as the basis for the rejection. Or, as it further appears, the patents relied upon as references simply do not teach the limitations of the claims.

5. Applicants have filed a further Response After Final traversing the remaining rejections, submitted June 5, 2006, and have noted with particularity several dependent claims (including those identified above) that have not been addressed in the rejections.

6. Applicants respectfully submit this petition in order to advance the prosecution of the instant application and to permit Applicants an opportunity to properly address the rejections that remain.

DISCUSSION

As noted above, Applicants filed a Response After Final seeking to have the Examiner withdraw the finality of the Office Action and to permit Applicants an opportunity to respond, or to further amend claims in the application, once the Examiner sets forth the basis for the rejections.

As a basis for this petition, Applicants urge that the Examiner has failed to meet the burden of setting forth the rejection to establish a case of *prima facie* obviousness to which Applicants can reply. In particular, the rejection fails to set forth specific rejections for all of the dependent claims. As illustrated in the excerpts above, the rejections also fail to set forth the particular portions of the description or figures relied upon in the referenced patents for teaching the claim limitations – particularly the limitations found in several of the dependent claims. In contravention of the requirements of MPEP 707.07(d) the Examiner appears to have grouped a plurality of claims together in a common rejection, and while referencing some limitations of some dependent claims, fails to set forth those portions of the cited patents relied upon as the basis for rejection for each of the dependent claims included in the rejection.

MPEP 706 states, “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” Furthermore, 37 CFR 1.104 makes it abundantly clear that Office Action must set forth the basis for the rejection of each claim, when it states, “(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” (emphasis added) Applicants respectfully contend that the above-noted obviousness rejections fail, in the rejections of the dependent claims, to identify a particular part relied upon to teach the limitations set forth in all of the dependent claims.

Lastly, since Applicants have demonstrated that the Examiner failed to provide a proper examination of the pending claims, and the Examiner failed to address such failure even when identified by Applicants in an earlier response, Applicants respectfully request that the Honorable Commissioner of Patents invoke the Honorable Commissioner's supervisory authority under 37 C.F.R. 1.181 and require the Examiner, should the Examiner not allow the present claims, to withdraw the finality of the present Office Action and issue a Non-Final Office Action to Applicants' pending response because the Applicant did not receive a proper examination of the amendments and arguments previously presented.

In summary, the final rejection is premature because the limitations of all dependent claims were not treated in the rejections, and the Examiner should be instructed to withdraw the finality of the rejection.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,



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June 7, 2006